

Remarks:

Reconsideration of the application is requested. Claims 1-24 and 49-57 are now in the application. Claims 1-24 and 49-52 have been amended. Claims 9-17 were previously withdrawn.

Support for new claims 53-54 is found in the original claim 1.

Support for new claims 55-56 is found in paragraph [0060] of the specification.

Support for new claim 57 is found in paragraph [0331] of the specification.

In item 3 of the Office action, the Examiner rejected claims 1-8, 19, and 24 as being obvious over Merritt (US 5,208,950) in view of Egan et al. (US 6,174,324) under 35 U.S.C. § 103(a). As will be explained below, the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references. Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Claim 1 calls for an implantable fastener that includes the following features:

a first section including a first surface and further including an extension member extending from said surface, and

a second section including a second surface, said second surface opposing said first surface and being configured for receiving the extension member, the first and second sections being bondable together with the application of an energy source;

said first surface being configured to abut the object and said second surface being configured to abut the object. (Emphasis added by Applicant.)

The invention according to claim 1 is patentable over Merritt '950 in view of Egan et al. '324 because the references fail to form a *prima facie* case of obviousness as is required under 35 USC § 103(a). *See* MPEP § 2142. As an initial matter, Merritt '950 has nothing to do with the subject matter of the instant application, i.e. methods and devices for securing body tissue. All pending claims recite an implantable fastener. Merritt '950 is for an elastic cord lock such as those used in vehicle restraining nets. There is nothing to indicate that Merritt's lock is

implantable or that one of ordinary skill in the art would even consider doing so. Merritt is simply non-analogous art. As a result, one of ordinary skill would not combine Merritt with Egan.

Even if Merritt is combined with Egan, the as-claimed invention would still not result. Nothing in the prior art suggests configuring the extension member to maintain the first surface and the second surface in a sandwiching position.

Merritt '950 teaches to secure an elastic cord within a lock by passing the cord along a tortuous path; *see* col. 2, lines 15-22. The lock (10) has two tortuous paths defined therethrough. The paths are defined, laterally, between the central web (68) and the cylindrically-shaped projections (80). The cord (16) is held by the curved surfaces in the path. The lock has a top interior surface (34) and a bottom interior surface (54). Neither of the top or bottom surfaces (34, 54) contacts or secures the cord. The central web (68) is integral with one of the surfaces (54) and can be ultrasonically welded to the other surface (34) to fix the upper portion to the lower portion; *see* c. 4, ll 33-36.

Egan et al., especially Figs. 8-12 and c. 4, l. 52, through c. 5, l. 22, teach a fastener that is folded over to define a top portion and a bottom portion. The suture strands (104) rest in recesses (112). The suture is then ultrasonically welded to the top. The suture is also ultrasonically welded to the bottom. In all cases, the suture forms the weld: "[T]he suture retaining device 102 can function as a stationary ultrasonic weld anvil and transmits vibrational energy to the suture strands within it, thereby effective relative motion between the strands and causing localized melting of the strands so as to create a molecular bond or weld between the suture strands." (*See* col. 5, ll 7-18; emphasis added by Applicant.) The top is never ultrasonically bonded to the bottom—only the suture is welded to either part.

At best, one with ordinary skill in the art of suture fasteners reading Merritt in view of Egan et al. might be taught to ultrasonically weld a suture to the curved lateral surface making a tortuous path.

One with ordinary skill reading Merritt in view of Egan et al. would not be suggested to sandwich a suture between two opposing surfaces and then fixing the surfaces in relation to each other by welding an extension member extending from a first of the surfaces to a second of the surface.

Because Merritt '950 in view of Egan et al. '324 fail to teach or suggest all of the features of claim 1, no *prima facie* case of obviousness has been formed. Therefore, claim 1 is patentable over the prior art. Moreover, because all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

The invention according to claim 3 is patentable over Merritt '950 in view of Egan et al. '324 for the additional reason that, while Merritt '950 does teach to weld the top to the bottom ultrasonically, Merritt '950 does not teach to weld the two together, "[T]o secure the suture." Claim 3 states, "The fastener according to claim 2, wherein the first and second sections are bonded together to secure the object." Merritt '950 teach to weld the top to the bottom to form a closed lock apparatus. In Merritt '950, the top and bottom are never used to sandwich the suture. In addition, as discussed previously, Egan et al. '324 does teach to weld the suture to the top or the bottom but does not teach to weld the top to the bottom.

Because neither Merritt '950 nor Egan et al. '324 teach to bond the top to the bottom to secure the suture, the prior art fails to form a *prima facie* rejection of the invention according to claim 3. Therefore, claim 3 is not obvious and patentable over the prior art.

Because claim 1 is a linking claim, Applicants request the rejoinder of withdrawn claims 9-17 if claim 1 is allowable.

In view of the foregoing, reconsideration and allowance of claims 1-24 and 49-52 are solicited. In the event the Examiner should still find any of the claims to be unpatentable, please telephone counsel so that patentable language can be substituted.

A petition for one month extension is attached.

Appl. No. 10/780,444
Amendment Dated April 23, 2009
Reply to Office Action of December 23, 2008

A Request for Continued Examination is attached.

A payment of \$600 is attached to provide for the extension of time, RCE, and extra five total claims.

No additional fee is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 782-A03-023).

Respectfully submitted,

/Paul D. Bianco/

Paul D. Bianco, Reg. No. 43,500

Customer Number: 33771

FLEIT GIBBONS GUTMAN BONGINI & BIANCO, P.L.
21355 East Dixie Highway
Suite 115
Miami, FL 33180
Tel: 305-830-2600
Fax: 305-830-2605
e-mail: PBianco@FGGBB.com